

**REMARKS**

This Amendment is in response to the Office Action mailed December 15, 2004. The Office Action rejected claims 1, 4-6, 9-10, and 12 under 35 U.S.C. §102, and rejected claims 2-3, 7-8, 11, and 13 under 35 U.S.C. §103. Claims 1, 3, 4 and 13 have been amended. Claims 14-17 have been added. Claims 1-17 remain pending in the application. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

**Rejections Under 35 U.S.C. § 102(e)**

The Office Action rejected claim 1-4, 9-10, and 12 under 35 U.S.C. 102(e) as being anticipated by Ladetto et al. (US 2003/0018430) (herein "Ladetto").

While Applicants disagree that Ladetto teaches the present invention as claimed, traversing this is unnecessary since Applicants conceived the claimed invention prior to Ladetto's filing date of April 23, 2001 and used due diligence from before April 23, 2001 until its constructive reduction to practice.

Under 37 CFR 1.131, an Applicant can submit an appropriate oath or declaration to overcome a patent or publication used as a rejection under 35 U.S.C. § 102(a) or 35 U.S.C. § 102(e), or 35 U.S.C. § 103 based on a 35 U.S.C. § 102(a) or 35 U.S.C. § 102(e) prior art reference. (See 37 CFR 1.131(a) and MPEP 715) An Applicant can overcome such patent or publication by either showing (1) reduction to practice prior to the effective date of the reference or (2) conception prior to the effective date of the reference coupled with due diligence from prior to said effective date to a subsequent reduction to practice or to a filing of a patent application for constructive reduction to practice. (See 37 CFR 1.131(b) and MPEP 715)

Ladetto is used as a reference under 35 U.S.C. § 102(e) to reject all pending claims - claims 1-4, 9-10, and 12. Ladetto was non-provisionally filed on April 23, 2001 and published on January 23, 2003.

Applicants' patent application (Ser. No. 10/664,176) claims priority on provisional application 60/412,348 filed on September 20, 2002, prior to the publication date of Ladetto on January 23, 2003. By comparison with Applicants' claims, Ladetto does not claim the same patentable invention and is not a statutory bar. Thus, it is proper for Applicants to submit declarations or oaths to overcome the Ladetto reference. Applicants herewith provide the declaration of Mr. Robert Levi and the accompanying Exhibits A, B, and C to show conception of the present claimed invention prior to April 23, 2001, Ladetto's filing date, coupled with due

diligence from prior to April 23, 2001, to the filing of the present application on August 17, 2003. Exhibits A, B, and C have been redacted by removing all dates thereon. However, all such dates are prior to April 23, 2001, Ladetto's patent filing date.

Exhibit A is a disclosure describing various aspects of the invention. This memorandum was prepared by Mr. Robert Levi, one of the named inventors, to disclose the concept a navigation device that detects an orientation and provide a corresponding heading signal (page 1, paragraph 1); one or more motion sensing devices to detect motion along different axis and provide corresponding motion signals (page 2, paragraph 1); and a processing unit (page 2, paragraph 1) communicatively coupled to the electronic compass and the one or more motion sensing devices (page 2, paragraph 2) to receive the heading signal and the one or more motion signals, determine a position and orientation, and automatically provide different navigation information depending on the orientation of the navigation device (page 2, paragraph 5). Additionally, Exhibit A discloses that the navigation device is mounted in a waist or holster (page 1, paragraph 4) and can be removed from the holster and held by hand (page 1, paragraph 4).

Exhibit B is part of a detailed report on an implementation of the invention where the use of accelerometers to determine orientation is disclosed (page 17, paragraphs 1-5; page 22, paragraphs 1-4).

Exhibit C is part of another report which describes how orientation can be used to control the performance of a navigation device, such as an electronic compass (page 3, paragraph 3).

Exhibits A, B and C and declaration clearly show that Applicants conceived and reduced the claimed invention to actual practice prior to April 23, 2001. As such, Applicants submit that their prior conception and diligence reduction to practice pre-dates the Ladetto reference.

For the foregoing reasons, Applicants contend that the Ladetto reference cited by the Office Action is not a prior art reference that may be used to obviate or anticipate Applicants' present invention. Accordingly, Applicants respectfully request the withdrawal of the 35 U.S.C. § 102(e) rejections of claims 1, 4-6, 9-10, and 12.

### Rejections Under 35 U.S.C. § 103

The Office Action rejected claim 2-3, 7-8, 11, and 13 under 35 U.S.C. 103(a) as being unpatentable over Ladetto et al. (US 2003/0018430) (herein “Ladetto”) in view of Kubo et al. (US 2002/0089425) (herein “Kubo”).

As to claim 2, the Office Action admits that the Ladetto does not disclose “[providing] different navigation information depending on whether the navigation device is affixed to a user or not.” (Page 4, Office Action). However, the Office Action states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teach[ing] of Ladetto et al. by combining provide different navigation information depending on whether the navigation device is affixed to a user or not for accurately determine a user heading and position information” (Page 4, Office Action).

The Office has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787 (Fed. Cir. 1984).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

According to MPEP § 2143.01, “a statement that modifications of the prior art to meet the claimed invention would have been ‘well within the ordinary skill in the art at the time the claimed invention was made’ ... is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references.” (MPEP § 2143) The teaching or suggestion to make the claimed combination must be found in the prior art, not in the Applicants’ disclosure.

“A suggestion or motivation to combine ... may also be inferred ... occasionally from the knowledge of those of ordinary skill in the art.” *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50

USPQ2d 1161, 1170 (Fed. Cir. 1999) (citing *In re Rouffet*, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998)). In *Al-Site* the accused infringer, VSI, argued that the patent at issue was invalid under 35 U.S.C. 103 as obvious over several prior art patents. VSI relied on "the level of knowledge of one of ordinary skill in the art at the time of the invention to supply the missing suggestion to combine." *Id.* The court did not find this persuasive. "Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *Id.* The court explained that the level of skill in the art provides a reference point to prevent the use of "insight or, worse yet, hindsight, to gauge obviousness." *Id.*

As in *Al-Site*, the question here is whether it would be obvious to modify a prior art navigation device (in Ladetto) where there is no suggestion for such a modification in the prior art by finding the motivation to combine in the ordinary skill in the art. Applicants submit that here, as in *Al-Site*, it is not.

The Office Action's assertion that "[i]t would have been obvious to ... modify the teach[ing] of Ladetto et al. by combining provide different navigation information depending on whether the navigation device is affixed to a user or not for accurately determine a user heading and position information" is insufficient to establish prima facie obviousness because no objective reason to make such modification is provided or found in the prior art. Applicants submit that the Office Action has failed to prove prima facie obviousness since it offers no objective reason why a person of ordinary skill in the art would modify the navigation device of Ladetto to "provide different navigation information depending on whether the navigation device is affixed to a user or not" as claimed.

"It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In Re John R. Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780.

Barring the Applicants' disclosure, the prior art does not provide a motivation to modify the teachings of Ladetto. Reliance in the ordinary skill in the art is misplaced since the Examiner is relying on hindsight.

Since none of the cited references expressly or impliedly suggest the desirability of their modification to configure a navigation device to operate differently depending on whether it is affixed to a user or not, and the Examiner has not presented a motivation for such modification which does not rely on the Applicants' disclosure, prima facie obviousness has not been shown.

As to independent claim 7, the Office Action states "Kubo et al. disclose determining whether the navigation device is affixed to a user (see at least [0032]; [0061]; [0065] through [0067]; and [0074])" (See page 5 of Office Action).

Applicants submit that Kubo teaches "a body motion detector that can be attached to or carried by a user for detecting body motions of the user" (Abstract) and can detect its own orientation. However, the body motion detector disclosed by Kubo does not detect whether it is affixed to the user as claimed. In particular, none of the cited paragraphs teach the limitation of "determining whether a navigation device is affixed to a user" as claimed. Kubo states "[t]he pedometer 10 of this invention can make measurements accurately even when it is being carried in a less than ideal manner such as in a pocket, by being hung from the neck or in a brief case." (Para. [0032]). Thus, the device in Kubo is intended to operate the same whether it is attached to the user or carried separately. Kubo teaches a device that detects its own orientation but not whether it is affixed to the user as claimed.

The present claimed invention, on the other hand, teaches that "[t]he navigation device 102 may also include a communication port or contacts 109 such that, when it is placed within the holster 106, it is capable of communicating over the link 110 and sensing that it is in place in the holster." (See Para. [0015]). In this manner the present claimed invention determines if it is affixed to the user and, if so, calculates a dead reckoning position. Applicants submit that this is a novel aspect of the invention that is not taught by any of the cited prior art. This same limitation is found in independent claim 12.

As to claim 8, the Office Action states "Ladetto et al. disclose determining an orientation of the navigation device relative to a horizontal plane (see at least [0046]), calculating a dead reckoning position if the navigation device is affixed to the user (see at least [0232] through [0234]), and calculating the dead reckoning position according to crawling ambulation when the

navigation device is affixed to the user and is in a second orientation (see at least [0236])” (Page 5, Office Action).

The Office Action admits, with reference to claim 7, that Ladetto et al. fails to teach “determining whether the navigation device is affixed to a user.” (See Page 5, Office Action). As such, Ladetto et al. cannot possibly teach different operating modes depending on whether the navigation device is affixed to the user as claimed. That is, Ladetto simply fails to recognize whether it is affixed to the user and, thus, fails to teach or suggest the limitations of claim 8.

Additionally, as discussed with reference to claim 2 above, the Office Action has failed to prove that it would have been obvious to modify the navigation device of Ladetto to operate in different modes depending on whether it is affixed to a user. The cited paragraphs in Ladetto, paragraphs [0232] through [0234], make no mention of the navigation device operating differently when affixed to the user as claimed.

As to claim 11, the Office Action admits that Ladetto et al. fails to teach “determining whether the navigation device is affixed to a user.” (See Page 5, Office Action). This same limitation is found in claim 7 and the arguments discussed above with reference to claim 7 also apply to claim 11. In particular, Applicants submit that paragraphs [0032]; [0061]; [0065] through [0067]; and [0074] in Kubo fail to disclose teach or suggest “determining whether the navigation device is affixed” to a user as claimed.

Additionally, the Office Action also admits that Ladetto does “not ... disclose suspending all motion measurement calculation if the navigation device is not affixed to the user.” (Page 5, Office Action) However, the Office Action states that “it is obvious that when the navigation device is not affixed to the user, there is no motion detected, and cannot measure any heading or position, therefore, all motion measurement calculation will be suspended.” (Page 6, Office Action).

Applicants submit that the reason put forth by the Office Action for suspending all motion measurement calculations (when the navigation device is not affixed to the user) is simply wrong. These navigation devices typically use accelerometers that can detect motion whether or not they are affixed to a user. For example, Kubo clearly discloses that the “[t]he

pedometer 10 of this invention can make measurements accurately even when it is being carried in a less than ideal manner such as in a pocket, by being hung from the neck or in a brief case.” (Para. [0032]). In these examples the navigation device is not “affixed to the user” (as defined in the present application) yet navigation information is still generated. Thus, Applicants submit that it is not obvious to suspend motion measurement calculations based on whether the navigation device is affixed to the user or not. Prima facie obviousness has not been established as to this limitation.

For at least the reasons discussed above, Applicants submit that the invention recited in claims 2-3, 7-8, 11, and 13 is patentably distinguishable over the cited prior art. Applicants respectfully request that the 35 U.S.C. § 103 rejection be withdrawn.

### Conclusion

In view of the amendments and remarks made above, it is respectfully submitted that the pending claims are in condition for allowance, and such action is respectfully solicited. Authorization is hereby given to charge our Deposit Account No. 19-2090 for any charges that may be due. Furthermore, if an extension is required, then Applicants hereby request such an extension.


Respectfully submitted,

Sheldon & Mak

I hereby certify that this document is being deposited on March 15, 2005 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313

By: Jennifer Hargis

  
Signature

  
Julio Loza  
Registration. No. 47,758

Dated: March 15, 2005